

## **REMARKS**

The above Amendments and these Remarks are in reply to the Office Action mailed November 6, 2003.

Currently, claims 1-27 are pending. Applicants have amended claim 1. Applicants respectfully request reconsideration of claims 1-27.

### **I. Summary of Office Action**

The drawings were objected to for not being of sufficient quality to permit examination.

Claims 1-27 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2003/0084121 ("*DeBoor*") and U.S. Patent No. 6,553,410 ("*Kikinis*").

### **II. Summary of Amendments**

Replacement formal drawing sheets, including Fig. 1 –Fig. 17, are submitted herewith and follow these remarks as Attachment A.

Claim 19 has been amended. No new matter has been added. The amendment is made exclusively to correct a typographical error and is not made in response to any objection or rejection by the Examiner, or for any other reason related to patentability.

### **III. Response to Drawing Objection**

Replacement formal drawings are submitted with this response. No new matter has been added by the drawing amendments. The replacement drawings are formal versions of the previously submitted informal drawings. It is respectfully submitted that the replacement drawings are of sufficient quality to permit examination. Accordingly, Applicants respectfully request withdrawal of the drawing objection.

### **IV. Response to Rejections**

Claims 1-27 were rejected under 35 U.S.C. 103(a) as being unpatentable over *DeBoor* and *Kikinis*. It is respectfully submitted that there is no reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the relevant field of invention would combine the cited art and furthermore, that even if the references are combined, the resulting combination fails to teach or suggest each of the limitations of claims 1-27.

A. There is no suggestion or motivation to combine the cited references

It is respectfully submitted that no suggestion or motivation to combine *DeBoor* and *Kikinis*, as suggested by the Examiner, has been shown, and furthermore, that there is no suggestion or motivation in the relevant field of art to combine the references.

The Examiner has combined the references, stating only that the references are “in the same field of endeavor” and that it would have been obvious to one of ordinary skill to have combined certain claim limitations “taught by *Kikinis* in the method of *DeBoor* to have the computer and computerized appliances maintained efficiently and significantly enhanced while greatly reducing the aggregate data traffic between data sources and dependent computers and appliances.” *Office Action*, pp. 3-4, ¶4. There is no statement of an explicit or implicit suggestion in either reference, or an implicit motivation in the knowledge generally available to one of ordinary skill in the art, whereby one would be led to combine the references as suggested.

It is further submitted that there is no suggestion or motivation to combine the references. Contrary to the Examiner’s assertion, the two references are in different fields of endeavor, neither of which is directed to the problem or solution addressed by Applicants’ claimed invention.

*DeBoor*, the Examiner’s primary reference, is directed to a “wireless communication device with a markup language based man-machine interface” that “provides a user interface for telecommunications functionality.” *DeBoor*, abstract (*emphasis added*). The “user interface pages written in a markup language” are “stored in a local memory of the wireless communication device.” (*Emphasis added*). *Id.* at p. 2, col. 0024; col. 25, ll. 51-53.

*Kikinis*, on the other hand, proposes “data templates for use in data simplification.” For example, *Kikinis* provides templates to “translate standard WEB pages into content-reduced WEB pages adapted for a specific client and/or application.” *Id.* at col. 25, ll. 54-58. *Kikinis* further discloses a “Mark-Script,” which is “a cross between a list of bookmarks and a script” that includes “a list of Web pages to be accessed on behalf of the client; and control routines adapted for accessing the WEB pages one-after-another.” *Id.* at col. 27, ll. 32-34; col. 3, ll. 31-37.

There is no explicit or implicit suggestion in either reference to combine them. Furthermore, one of ordinary skill in the art would not be motivated to combine teachings directed to user interface pages stored in local memory of a wireless device with teachings directed to data templates “adapted to translate standard WEB pages” or Mark-Scripts “adapted for accessing Web pages one-after-another,” since the problems and solutions addressed by each are different. *Id.* at col. 25, ll. 34-38; col. 3, ll. 31-37.

In addition to addressing distinct problems and solutions, neither of the two references is related to problems or solutions addressed by Applicants' claimed invention. Applicants' claims are directed to methods and media "for use in performing server actions," with a template stored at "a location accessible to a server machine." In contrast, *DeBoor* proposes user interface pages stored in local memory while *Kikinis* proposes data templates and Mark-Scripts for translating and accessing Web pages and other content.

As there is no reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination proposed by the Examiner, a prima facie case of obviousness can not be established.

B. The Combination Fails to Teach or Suggest the Limitations of Claims 1-27

Even if the references are combined as set forth by the Examiner, the resulting combination fails to teach or suggest each of the limitations of claims 1-27, and hence, the claims are patentable over the cited art.

Claims 1-18

The combination of *DeBoor* and *Kikinis* fails to teach or suggest:

"storing, at a location accessible to said server machine, a template for use in *performing server actions*, wherein the template includes a *field*, and *attribute data* associated with the field, wherein the attribute data *indicates whether it is necessary to obtain information to complete the field from users* of the template," as recited in claim 1 (*emphasis added*).

*DeBoor* fails to teach or suggest "a template for use in performing server actions." *DeBoor*, as cited by the Examiner, discloses, "user interface pages written in a markup language," that are "stored in a local memory of the wireless device," and that are used to define "the telecommunication control and other functions of the wireless communication device." *DeBoor*, p. 2, col. 0024. The user interface pages of *DeBoor* define functions of a wireless device, not server actions.

Further, there is no teaching or suggestion of a template that "includes a field, and attribute data associated with the field, wherein the attribute data indicates whether it is necessary to obtain information to complete the field from users of the template." *DeBoor*, as cited by the Examiner, merely discusses the "deficiencies of HTML," stating that:

[f]orms as they exist in content today tend to be too large for the user to maintain some context as she is filling them in on a small screen. If the form is divided into n forms, then the user's input is sent between the client and the

server and back to the client n-1 times, wasting bandwidth. In addition, with a series of smaller forms, terminating the transaction could be tortuous as the user hits the back key for each form in the series. *DeBoor*, p. 4, col. 0035.

Nothing in *DeBoor*'s discussion suggests including an attribute in a template that "indicates whether it is necessary to obtain information to complete the field from users of the template," as recited in claim 1.

Still further, *DeBoor* fails to teach or suggest "performing a server action using the template wherein the step of performing the server action includes: determining from the attribute data whether it is necessary to obtain information to complete the field," as recited in claim 1. In *DeBoor*, "[e]ach control function is associated with, or activated by a Uniform Resource Locator (URL)," which is a "data item specifying a protocol for obtaining a data item, and which data item should be fetched or manipulated." *Id.* at p. 2, col. 0024. The URL "specifies a communication protocol that should be used to retrieve the data," such as http for files on the World Wide Web and the "file protocol to obtain data in a local file system stored in the memory." *Id.* at p. 6, col. 0084. *DeBoor* addresses communication protocols for retrieving data, not templates, attribute data, and server actions. *Id.* Accordingly, nothing within *DeBoor* teaches or suggests that the URL "indicates whether it is necessary to obtain information to complete the field from users of the template," or "determining from the attribute data whether it is necessary to obtain information to complete the field," as recited in claim 1.

It is further submitted that even if combined with *DeBoor*, *Kikinis* fails to cure the deficiencies identified in *DeBoor* above, and furthermore, fails to teach or suggest the individual limitations asserted by the Examiner. First, *Kikinis* is not directed to, nor does it teach or suggest "a template for user in performing server actions," as recited in claim 1. *Kikinis* is directed to data templates to "translate standard WEB pages into content-reduced WEB pages adapted for a specific client" and Mark-Scripts for accessing a sequence of URLs." See *Kikinis*, col. 25, ll. 54-58. *Kikinis*'s templates merely translate content for specific clients. Accordingly, *Kikinis* fails to cure the deficiencies of *DeBoor* because there is no teaching or suggestion relating to "performing a server action using the template," wherein the template includes a field and "attribute data [that] indicates whether it is necessary to obtain information to complete the field from users of the template," as recited in claim 1.

Furthermore, *Kikinis* also fails to show :

"if it is not necessary to obtain information to complete the field, then performing the server action without obtaining information from the client machine to complete the field; and

if it is necessary to obtain information to complete the field, then obtaining information from the client machine to complete the field prior to performing the server action,” as alleged by the Examiner.

*Kikinis*, as cited by the Examiner, discloses a Mark-Script which is “a cross between a list of bookmarks and a script.” *Id.* at ll. 31-33. The Mark-Script comprises “a list of Web pages to be accessed on behalf of a client; and control routines adapted for accessing the WEB pages one-after-another.” *Id.* at col. 3, ll. 31-37. There is no mention of fields of a template, much less alternate steps to be performed as part of a server action depending on “whether it is necessary to obtain information to complete the field,” as determined from attribute data of a template. Accordingly, *Kikinis* fails<sup>1</sup> to teach or suggest “performing the server action without obtaining information from the client machine to complete the field,” in one instance and “obtaining information from the client machine to complete the field prior to performing the server action,” in another, as set forth in claim 1.

Since, *DeBoor* and *Kikinis*, alone or in combination, fail to teach or suggest each of the limitations of claim 1, it is respectfully submitted that claim 1 is patentable over the cited art. Claims 2-18 each ultimately depend from claim 1 and should be patentable for at least the reasons set forth with respect to claim 1.

#### Claim 19

The Examiner asserted that Claim 19 “has the same limitation as to claim 1 therefore under the same circumstances claim 19 can be rejected.” *See Office Action*, p. 8, ¶ 20. It is respectfully submitted that, while claim 19 does contain some limitations similar to claim 1 that render it patentable for at least the reasons set forth above, claim 19 also includes additional limitations not taught or suggested by the combination of references.

For at least the reasons set forth with respect to claim 1, it is asserted that ~~the~~<sup>1</sup> combination of references fails to teach or suggest, “storing, at a location accessible to a server machine, a plurality of templates associated with a plurality of server actions that the server machine can perform,” and “performing said particular server action using data from said template as at least a portion of the user input required for said particular server action,” as recited in claim 1. As set forth above, *DeBoor* discloses “user interface pages” that define “telecommunication control and other functions of the wireless device,” while *Kikinis* discloses templates “for use in translating WEB data to a reduced-data form to be transmitted to a client device from a WEB server.” *DeBoor*, p. 2, ¶ 0024; *Kikinis*, col. 3, ll. 8-10.

Accordingly, even if combined, the resulting combination does not teach or suggest storing templates “associated with a plurality of server actions that the server machine can perform,” and performing a “server action using data from said template as at least a portion of the user input required,” as recited in claim 19. Therefore, it respectfully submitted that claim 19 is patentable over the cited art.

#### Claims 20-23

It is respectfully submitted that the combination of references fails to teach or suggest:

“receiving a signal from said client machine that indicates whether to use said template to perform said server action;  
if said signal indicates to use said template to perform said server action, then performing said server action using said first user input as user input for one or more of said plurality of fields,” as recited in claim 20.

The combination of *DeBoor* and *Kikinis* fails to teach or suggest templates for use in performing server actions, as set forth with respect to claim 1, and thus, also fails to teach or suggest the above-identified limitations of claim 20. The Examiner recognized that *DeBoor* fails to teach or suggest the above-identified limitations, and cited *Kikinis*’s disclosure of template creation for the deficient limitations. *Kikinis*, however, discloses templates “provided for use in translating WEB data to a reduced-data form to be transmitted to a client device from a WEB server.” *Kikinis*, col. 3, ll. 8-10. The templates are used to translate data for transmission to a client device, not in the performance of server actions.

The portion of *Kikinis* cited by the Examiner is directed to clients that “are adapted via software to make new templates for specific WEB pages and client devices and appliances.” *Kikinis*, col. 26, ll. 1-3. *Kikinis* merely describes embodiments for creating new templates, such as by “modifying a standard or default template.” *Id.* at ll. 3-4. There is no teaching or suggestion that the created templates are used in the performance of server actions. As already described, the templates of *Kikinis* are “provided for use in translating WEB data to a reduced-data form to be transmitted to a client device,” not for performing server actions. See *Kikinis*, col. 3, ll. 8-10. Thus, *Kikinis* does not teach or suggest receiving a signal from a client machine “that indicates whether to use said template to perform said server action,” or “performing said server action using said first user input as user input for one or more of said plurality of fields,” if the signal so indicates, as recited in claim 20.

Since the combination of references fails to teach or suggest each of the limitations of claim 20, it is respectfully submitted that claim 20 is patentable over the cited art. Claims 21-23 each

ultimately depend from claim 20, and therefore, should be patentable for at least the reasons set forth with respect to claim 20.

Claims 24-27

Claim 24 recites a computer readable-readable medium including instructions for performing the steps set forth in claim 20. Accordingly, claim 24 should be patentable over the cited art for at least the reasons set forth with respect to claim 20. Claims 25-27 each ultimately depend from claim 24, and therefore, should be patentable for at least the same reasons as claim 24.

**V. Conclusion**

Based on the above amendments and these remarks, reconsideration of claims 1-27 is respectfully requested.

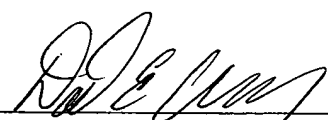
The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond to the Office Action, up to and including today, February 26, 2004.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 2/26/2004

By:   
David E. Cromer  
Reg. No. 54,768

VIERRA MAGEN MARCUS HARMON & DENIRO LLP  
685 Market Street, Suite 540  
San Francisco, California 94105-4206  
Telephone: (415) 369-9660  
Facsimile: (415) 369-9665

ATTACHMENT A